

REMARKS

Claims 22-35, 37-51, and 53-73 are pending. Claim 73 is rejected under 35 U.S.C. § 112, first paragraph, as containing matter not described in the specification. Claims 22-35, 37-51, and 53-73 are rejected under 35 U.S.C. § 103(a) as obvious over Reichle.

Claims 21, 23, 29, 35 - 37, 43, 45, 49, 52, 54, 56, 57, 62, 64, and 68 have been canceled without prejudice. Claims 22, 24-35, 38-42, 44, 46-48, 50-51, 53, 55, 58-61, 63, and 65-72 have been amended to exclude the possibility that Y is -O-. No new matter has been added by these amendments.

New claims 74-104 are presented for examination. New claims 74-81 have Y as -O- with the choices for M, X, and R' being limited to those groups that the Examiner has indicated are supported in Nagy I. Accordingly, these claims should now be allowable. New claims 82-104 have Y as -O- with the full range of choices disclosed in the present application (Nagy II). These claims should be allowable for the reasons set forth below.

A. Claim Objection

Claim 73 is objected to for having an inadvertent period after M. Claim 73 is now cancelled.

B. Rejection Under 35 U.S.C. § 112

Claim 73 is rejected under 35 U.S.C. § 112, first paragraph, as containing matter not described in the specification. Claim 73 is now canceled. New claim 104 which is directed to Y only being oxygen includes the proviso - "with the proviso that trichlorotitanium 8-quinolinate, dichlorotitanium bis(8-quinolinate), and monochlorotitanium tris(8-quinolinate) are excluded" which formed the basis of the 112 rejection of claim 73. Applicants restate their previous arguments of record that the exclusion of the three compounds in this proviso is not new matter under current case law. (Applicants' September 13, 1999 Amendment under 37 C.F.R. § 1.111)

B. Rejection Under 35 U.S.C. § 103(a)

Claims 22-35, 37-51, and 53-73 are rejected under 35 U.S.C. § 103(a) as obvious over Reichle et al. U.S. patent 5,852,146 (hereinafter, *Reichle*). Claims 23, 29, 35, 37, 43, 45, 49, 54, 56, 57, 62, 64, and 68 have been canceled. Claims 22, 24-35, 38-42, 44, 46-48, 50-51, 53, 55, 58-61, 63, and 65-72 have been amended to exclude the possibility that Y is -O-. The Board of Patent Appeal and Interferences has indicated that

As to the first group of limitations directed to the definition of Y, we find that the corresponding Y of Reichle is limited exclusively to -O-, oxygen. This is no teaching or suggestion of moieties other than oxygen. Accordingly, the newly inserted limitations of the claimed subject matter need not be given further consideration as no *prima facie* case of obviousness can be established with respect to moieties neither taught by, nor suggested by Reichle.

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Accordingly, claims 22, 24-35, 38-42, 44, 46-48, 50-51, 53, 55, 58-61, 63, and 65-72 are not unpatentable over Reichle and are in condition for allowance.

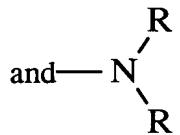
New claims 82 - 104 are directed to the equivalent subject matter of claims 22-35, 37-51, and 53-73 with Y being oxygen which in accordance to the Board's Decision On Appeal implied is the crux of the 103(a) rejection. (Decision On Appeal, p. 6.) Applicants restate their previous argument of record in which they argued:

- 1) *Reichle* is only "a reference under 35 U.S.C. § 103(a) through 35 U.S.C. § 102(e), and since there is no dispute that the claimed subject matter of *Reichle* and the present invention do not overlap, Applicants are entitled, under 37 C.F.R. § 1.131, to swear behind *Reichle*, thus removing *Reichle* as a reference." (Applicants' August 7, 2000 Amendment under 37 C.F.R. § 1.111);
- 2) The present application is entitled to the *Nagy* parent application's filing date of April 17, 1995, more than one year prior to the *Reichle* filing date (Applicants' August 7, 2000 Amendment under 37 C.F.R. § 1.111); and

3) The *Nagy* parent application provides evidence of a conception and reduction to practice (37 C.F.R. § 1.131) earlier than *Reichle*'s filing date (Applicants' August 7, 2000 Amendment under 37 C.F.R. § 1.111).

Accordingly, for these same reasons, new claims 82 to 104 are patentable over *Reichle*.

Notwithstanding restatement of Applicants' previous arguments, Applicants present the following new insight. The proper comparison between the X group in *Reichle* is not just the X group of the present invention. Instead, the combination of the X group and the L group in the present application must be compared to *Reichle*. The parent application for the present case, U.S. Patent No. 5,637,660 (the '660 patent) disclosed that "X is independently selected from the group consisting of halogen, C₁ to C₆ alkyl, C₁ to C₆ alkoxy,

and—, L is X, cyclopentadienyl, C₁ to C₆ alkyl substituted cyclopentadienyl, indenyl,

fluorenyl, . . ." A person skilled in the art of organic chemistry would recognize that indenyl and fluorenyl are moieties which include aromatic rings. Moreover, one skilled in the art of organic chemistry would recognize that these terms provide a selection of positions to which bonding may occur. Therefore, the parent application did disclose the possibility of the equivalent groups to the *Reichle* patent as being aryl. Accordingly, this is further evidence that the newly claimed limitations of the present invention are within the scope contemplated by the '660 patent.

Conclusion

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, he is highly encouraged to telephone Applicants' attorney at the number given below.

A check in the amount of \$110.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,
NAGY ET AL.

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Date: June 26, 2003

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